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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/664,604	09/16/2003	Gary Wayne Hamilton	AB190/99001	3612
7590	12/16/2005		EXAMINER LEE, JONG SUK	
David W. Carrithers CARRITHERS LAW OFFICE One Paragon Centre 6060 Dutchman's Lane, Suite 140 Louisville, KY 40205			ART UNIT 3673	
PAPER NUMBER				

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/664,604

Applicant(s)

HAMILTON ET AL.

Examiner

Jong-Suk (James) Lee

Art Unit

3673

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/22/05 & 11/28/05.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 1,7,8,12-15,17,19,25 and 30 is/are allowed.
6) ☒ Claim(s) 2-6,9-11,16,18,20-24,26-29 and 31-33 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed on September 22, 2005 has been entered.

Terminal Disclaimer

2. The terminal disclaimer filed on September 22, 2005 and November 28, 2005, respectively, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,129,163 and US Patent No. 6,619,413 has been reviewed and is accepted. The terminal disclaimers have been recorded.

Information Disclosure Statement

3. The information disclosure statement filed April 9, 2004 fails to comply with 37 CFR 1.98(a)(1), which requires the following: **(1) a list of all patents, publications, applications, or other information submitted for consideration by the Office (PTO-1449); (2) U.S. patents and U.S. patent application publications listed in a section separately from citations of other documents; (3) the application number of the application in which the information disclosure statement is being submitted on each page of the list; (4) a column that provides a blank space next to each document to be considered, for the examiner's initials; and (5) a heading that clearly indicates that the list is an information disclosure statement.** The information disclosure statement has been placed in the application file, but the information referred to therein has not been considered.

Further, the IDS letter filed April 9, 2004 disclose incorrect issued Patent No. 6,119,413 which should be corrected to be US Patent No. 6,619,413.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2-6, 9-11, 16, 20-24, 26-29, 32 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Morse (US 4,077,737).

The preamble limitation, "A flight rock auger for removing plugs of hard material from post holes" is intended use and patentable weight is not given to the preamble.

Morse discloses a core drill comprising of: a cylindrical hollow cutting head comprising a hollow cylindrical body (25) defining side walls connecting a top end defining an upper peripheral edge and a lower open end defining a lower peripheral cutting edge including a plurality of teeth (28) extending from the lower peripheral edge; the top end of the hollow cylindrical body (7) including at least one support member (15) extending across at least a portion of the top end joining the side walls, the support member having at least one opening; a shaft/shank (32) having a diameter less than the cutting head, the shaft (32) including a proximal end connecting to the at least one support member (15) and having an opposing distal end extending therefrom; and a pilot/center drill (8) extending from the shaft (32) disposed within the cylindrical hollow cutting head and extending in axial alignment with the shaft, wherein at least a

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portion of a tip of the pilot drill extends past the teeth extending from the lower peripheral edge of the cutting head, means for connecting (34, 35) the distal end of the shaft to a drive shaft of a power unit; the hollow cylindrical body including a cutaway portion/openings (25) on the side wall and extending around the periphery thereof a selected length forming a side wall edge extending along the cutaway portion (see Figs. 1-2; col.4, lines 17-68; col.5; lines 1-68; col.6, lines 1-38).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 1038 and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 18 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morse et al in view of Hill (US 2,021,184). The teachings of Morse et al have been discussed above.

However, Morse fails to disclose or fairly suggest a quick disconnect assembly as the means for connecting to a power unit. Hill discloses a drilling structure and a drill bit comprising of: a cylindrical hollow cutting head (35) defining a hollow cylindrical body having a top end

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and a lower open end including a plurality of teeth (41) extending from the lower peripheral edge, the teeth (41) angled forwardly and outwardly protruding past the lower peripheral edge, the hollow cylindrical body having an upper section (37) and a lower section defining a greater exterior diameter than the upper section; means (24) for cooperative engagement with a shaft/drill pipe section (10, 11) extending outwardly therefrom; a quick disconnect coupling (15), disposed upon the distal end of the shaft (10), including a female socket end for cooperative engagement with a male end of a drive shaft (13) of a motor; a support member (32) connecting the top end of the cylindrical body member with the shaft (11); a plurality of openings (44) on the top end of the cylindrical body for mud circulation; a core sample is taken through the bore (40) of the cutting bit (35) (see Figs.1-5; pg.2, right col. lines 30-75; entire pg.3).

Therefore, in view of Hill, it would have been obvious to one of ordinary skill in the art at the time the invention was made to add the quick disconnect coupling to the drive shaft of Morse in order to reduce the time of operation and cost.

Response to Arguments

8. Applicant's arguments with respect to Hill reference that a hollow center being necessary through the drill stem and bit taking core samples are not persuasive because the Hill reference was meant to be viewed in combination with the Morse reference and neither was meant to be viewed individually. Morse reference discloses most of the claimed features of claims 2, 18, 28 and 31 except the quick disconnect assembly which the Hill reference discloses.

With respect to amended claim 1, the opening in the side wall extending downwardly from the top edge of the tubular body to provide the cutaway portion to the side wall is defined over the prior art of record. Therefore, art rejection over claim 1 is withdrawn.

The Morse reference are still readable over the claims rejected insofar as the cutaway portion is claimed to be extending along or around the periphery thereof a selected length forming an opening extending along a portion of the side walls. Further, the lateral sidewall edge can be understood to be any edge or cutoff portions formed in the side wall rather than the peripheral edge of the side wall.

Allowable Subject Matter

9. Claims 1, 7, 8, 12-15, 17, 19, 25 and 30 would be allowable over the prior art of record.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (571) 272-7044. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather C. Shackelford can be reached on (571) 272-7049. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
December 12, 2005



Jong-Suk (James) Lee
Primary Examiner
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